

REMARKS

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 are in the application. Claims 1, 16 and 20 are currently amended; claims 1, 2, 7 – 9, 11 – 14, 16, 17, 20, 24, and 25 were previously presented; claims 3 – 5, 10, and 21 – 23 are cancelled; and claims 15, 18, and 19 remain unchanged from the original versions thereof. Claims 1, 16, and 20 are the independent claims herein.

No new matter is added to the application. Reconsideration and further examination are respectfully requested.

Claim Rejections – 35 USC § 112

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

Applicant notes that the Examiner admits at page 3 of the Final Office Action dated October 19, 2006 (referred to herein as the FOA) that the Specification explicitly states one exemplary way to implement the invention. The Examiner also restates the operations of claim 1 including the calculating of the plurality of risk assessment values, the calculating of a risk quotient, and the generation of a suggested action in response to the calculated risk quotient.

Applicant respectfully submits that the Specification, including the portions cited by the Examiner, clearly illustrate that the Specification is in compliance with 35 SC 112, 1st paragraph. For example, the Examiner asks how is the numerical value assigned to the risk assessment factors and what determines how the values gets assigned. In reply thereto, Applicant submits that the Specification provides in full, clear, concise, and exact enabling terms the manner in which the claimed invention may be made and used. That is, the exemplary manner of practicing the invention

provided in the Specification (admitted as such by the Examiner) is enabling with respect to the invention claimed by Applicant.

Further, the questions asked by the Examiner do not pertain to necessary aspects of the claimed invention and the Specification. For example, those skilled in the pertinent arts related to the claimed subject matter to which the application pertains would understand how to assign a numerical value to a risk assessment factor since such an understanding requires only a basic understanding of, for example, variables and associated values. Stated another way, assigning values to variables is well-known and need not be repeated or explained by Applicants in view of the scope of the pending claims.

The Examiner also states that there is no detailed or concrete, full, concise and exact written description of how one would quantify or assign values, and would require subjective analysis. However, Applicant notes that the claims require calculating by multiply and calculating by summing, as disclosed in the explicit example of the Specification. The calculating operations of the claims and the explicit example do not require any subjective analysis of values, instead stating two calculating operations.

Referring the paragraphs [0045] – [0047], Applicant notes that the Specification discloses a concrete result obtained by the disclosed and claimed method. Namely, the Specification discloses generating a suggested action in response to the calculated risk quotient. Applicant submits that the suggested action generated in response to the calculated risk quotient is a concrete result that can be repeated by, for example, performing the invention as detailed in the explicit example in the Specification.

Furthermore, the result (i.e., the suggested action) is repeatable. Note, a result will be obtained each time the explicit example process of the Specification is performed. Even in the instance a different value is obtained, a concrete result will be achieved. That is, the Specification disclosed (and claimed) result will be obtained each time.

Therefore, Applicant respectfully submits that the Specification does in fact disclose a concrete repeatable result.

Starting at page 6 of the FOA, the Examiner states and argues that the transitional phrase “consisting of” is used without support in the Specification. This argument is factually incorrect and without merit.

First, Applicant does not use “consisting of” as a transitional phrase between the preamble of a claim and the body of the claim’s limitations. To the contrary Applicant uses the words “consisting of” in the course of reciting a Markush style of claiming the invention. The Examiner is invited to refer to MPEP 2173.05(h).

Secondly, the Examiner appears to argue that Applicant is prohibited from claiming that which it considers the invention in any but the broadest terms disclosed in the Specification. Applicant disagrees with this characterization of acceptable patent practice. Applicant further requests the Examiner to substantiate the claiming prohibitions alleged in the FOA (e.g., MPEP, 35 USC, case law, etc.).

Accordingly, Applicant respectfully submits that the use of the term consisting of in the context of a Markush claim is proper and valid.

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 were rejected under 35 U.S.C. 112, second paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection.

The Examiner seeks clarification regarding what numerical values and who assigns the numerical value to the risk assessment factors in arguing the rejection of the claims under 35 USC, 2nd paragraph. However, Applicant reiterates that “who” assigns the numerical value is not relevant to the claims and what specific “values” assigned to the variable risk assessment values are not necessary or required in view of the scope of the pending claims.

Accordingly, Applicant respectfully submits that the claims are acceptable under 35 USC, 2nd paragraph.

Claims 1, 2, 6 - 9, 11 - 20 and 24 - 27 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully traverses this rejection.

The Examiner repeats that the claimed invention is not repeatable and would further require undue experimentation. Applicant reiterates that the claimed process of calculating a risk quotient and generating a suggestion in response to same is repeatable. Again, even in an instant the specific values obtained may be different the claimed result itself will be obtained. Further, the claimed operations of calculating and generating are each objective operations or steps.

The Examiner states that it is not clear that the end result is predictive. In reply thereto, Applicant responds that it is "predictive" in that the claimed result will be obtained, as discussed above. Also, the "list of the elements" necessary to obtain the claimed result are claimed and disclosed in the example in the Specification.

Again, the result of generating a suggestion based on the calculated risk quotient is a concrete and repeatable result.

Claim Rejections – 35 USC § 101

Claims 1 - 2, 6 - 9, 11 - 20, and 24 - 27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This rejection is traversed.

Applicant respectfully submits that the rejection under 35 U.S.C. 101 is overcome by the pending claims. The claimed invention is (1) within the technological arts and (2) the claimed invention produces a useful, concrete, and tangible result (e.g., provide a suggested action associated with the legal action).

In particular, the claimed result is in fact a concrete and tangible result. The claimed result is also reproducible, as discussed above. That is, one practicing the claimed invention would in fact be able to calculate a risk quotient and in response thereto generate a suggested action associated with the legal action, as recited in the claims.

Applicant points out that a particular or exact risk quotient value or a specific suggested action is not claimed by Applicant. Despite this fact, the Examiner appears to suggest that the claims include such specificity. Applicant respectfully submits that one skilled in the art could repeat and implement the claimed invention without undue experimentation to an extent commensurate with the claims and the Specification.

The result of "generating a suggested action associated with the legal action" is reproducible.

Therefore, Applicant respectfully requests the reconsideration and withdrawal of the rejection of claims 1, 2, 6-9, 11-20, and 24-27 under 35 USC 101.

Claim Rejections – 35 USC § 103

Claims 1-2, 6-9, 11-20, and 24-27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Heckman et al. U.S. Patent No. 5,875,431 (hereinafter referred to as Heckman).

Regarding claims 1, 16, and 20, Heckman system receives three kinds of data: initial data directed to the administrative and demographic particulars of each law firm subscribed to the system, case specific data relating to the present case, and case outcome feedback data from which future litigation/legal templates might be drawn (col. 16 lines 16- 21). Heckman further states,

In addition to collecting information on the company's trade secrets, an evaluation should be done to determine whether the trade secret is likely to meet the tests applied by the courts. In the United States, Section 757 of the First Restatement of Torts set forth six factors for evaluating the

existence of a trade secret to assist the courts in adjudicating trade secret cases. One of the inventions we claim is a method of using the six factors to document, weight, and evaluate the existence of a trade secret and measures to protect the trade secret. (emphasis added)

Thus, it is clear that the six factors regarding a trade secret are used to document, weight, and evaluate the existence of a trade secret and measures to protect the trade secret. The factors disclosed in Halligan are not the same as the claimed risk assessment factors. The Halligan factors, even when used in the context of determining a basis of a tort, only relate to the determination of whether a trade secret exists. That is, the Halligan disclosed factors do not relate to the claimed risk assessment factors and the Halligan factors are not the same as or suggestive of Applicant's claimed risk assessment factors.

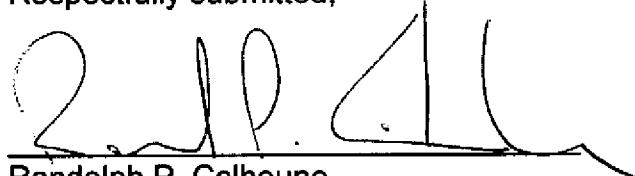
Thus, as clearly illustrated above, Halligan fails to disclose that for which it was cited and relied upon for disclosing. Halligan was cited and relied upon to correct the failings of Heckman. Halligan however also fails to disclose those aspects of the claims not disclosed by Heckman.

Therefore, it is clear that even if Heckman and Halligan were combined as asserted by the Examiner (not admitted as feasible by Applicant), the combination would not render claims 1, 16, and 20 obvious due to the patentable differences between the claims and the combination of Heckman and Halligan. Accordingly, Applicant respectfully submits that claims 1, 16, and 20 are patentable over Heckman and Halligan under 35 USC 103(a). Furthermore, claims 2, 6-9, 11-15, 17-19, and 24-27 depend from claims 1, 16, and 20. It is further submitted that all of the pending claims 1, 2, 6-9, 11-20, and 24-27 are patentable over Heckman and Halligan under 35 USC 103(a).

CONCLUSION

Accordingly, Applicants respectfully request allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-5985.

Respectfully submitted,



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